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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 217

BENJAMIN STEIN, RENA STEIN, AND HENRY KUTNER, DOING BUSINESS AS REGLOR OF CALIFORNIA,
Petitioners,

vs.

EXPERT LAMP COMPANY, A CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

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July 30, 1951.

THE DUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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Petitioners, Benjamin Stein, Rena Stein, and Henry Kutner, doing business as Reglor of California, pray that a writ of certiorari issue to review the judgment of the Court of Appeals for the Seventh Circuit (R. 56-60) in the above-entitled cause, affirming the decision of the United States District Court for the Northern District of Illinois, Eastern Division (R. 41). A petition for rehearing was denied (R. 60).

Opinions Below.

The memorandum opinion of the District Court appears at page 41 of the record and the opinion of the Court of Appeals at page 56. The opinions are reported at 96 F. S. 97 and 188 F. (2d) 611, respectively.

Jurisdiction.

The jurisdiction of this Court is founded upon Title 28, Section 1254(1), United States Code. The judgment of the Court of Appeals, which Petitioners here seek reviewed, is dated May 22, 1951. This petition is filed before August 20, 1951, and is, therefore, timely.

Question Presented.

Is a copy of a copyrighted statuette, otherwise an infringement, outside the scope of the copyright because the copy is sold as part of a complete lamp, when the artistic features of the original statuette are in full view in the copy and are wholly unrelated to and unaffected by the functional purpose of the lamp?

In other words, can an infringement of a copyrighted work of art be made less so by adding utilitarian parts that do not alter the artistic impression?

Statutes Involved.

The questions here presented involve the construction of the Copyright Code, 17 U. S. C. 1 and 5 (g), which, in its relevant portions, reads:

> "§ 1. Exclusive Rights as to Copyrighted Works.—Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:
>
> (a) To * * * copy, and vend the copyrighted work;"
>
> * * * * *
>
> "§ 5. Classification of Works for Registration.—The application for registration shall specify to which

of the following classes the work in which copyright is claimed belongs:

* * * * *

(g) Works of art; models or designs for works of art."

This case also involves Regulation 202.8 of the Copyright Office, reading as follows:

"§ 202.8. Works of art (Class G)—(a) In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. * * *"

Also involved in this case is the Design Patent Law, reading in part:

"Any person who has invented any new, original, and ornamental design for an article of manufacture, * * * may * * * obtain a patent therefor." (35 U. S. C. 73, R. S. 4929, 4933.)

Statement of the Case.

This is an action for infringement of copyrights 976G and 977G entitled "Sculptured Figure of Female Balinese Dancer" and "Sculptured Figure of Male Balinese Dancer," respectively (R. 19-20). These copyrights were granted upon the basis of specimens submitted to the Copyright Office in the form of statuettes (R. 52a-55). The specimens were simply statuettes, without lamp socket supports, lamp cord holes, or other additional parts required for use of the statuettes in complete lamps (R. 55). The copyrights are in class G, "Works of Art" (R. 19-20).

The statuettes here accused are identical in every artistic respect with the copyrighted statuettes, even to such im-

material detail as size and the author's name worked into the filagree of the female skirt (R. 17-18). The sole differences lie in the functional and inconspicuous additions of (1) a threaded tube protruding from the head to receive a lamp socket and (2) a hole from the base to the tube to receive a lamp cord (R. 10C and 54A). It is not disputed that when the lamp, shade, cord, and other parts are added to make a complete lamp, the statuette remains in full view and that the pleasing artistic concepts of its creator are enjoyed in full by viewers of the copy.

Plaintiffs-Petitioners filed motion for preliminary injunction (R. 6). Defendant-Respondent filed a countermotion to dismiss the case (R. 25). The motion for injunction was denied and the motion to dismiss granted by the District Court (R. 41). The Court of Appeals affirmed (R. 56).

The substance of the opinions below is that, despite complete appropriation of every artistic feature of the original statuettes, the copies here accused are outside the scope of the copyrights because lamp sockets and other parts have been added to form a lamp.

There is some confusion in the opinions below with respect to the specimens submitted to the Copyright Office. The present record shows, and Defendant-Respondent admits, that the specimens were simply statuettes, without protruding stubs to receive lamp sockets or holes for lamp cords (R. 55).

Specification of Errors.

The Court of Appeals erred in reading Section 5 (g) of the Copyright Code as limited by the Design Patent Law, so as to immunize from copyright liability a statuette, sold and used as a lamp base, embodying every element of art in the copyrighted original and copied from the original.

Reasons for Granting the Writ.

1. The decision of the Court of Appeals is irreconcilable with the regulations and practice of the Copyright Office and creates administrative confusion in an important activity of the Copyright Office.

The Copyright Office has adopted a regulation under which "works of artistic craftmanship" are registrable "in so far as their form" is concerned (This Petition, p. 3). Under this regulation the Copyright Office grants registrations to artistic jewelry, fine glassware, sculptured lamp bases, and other works of artistic craftsmanship which meet the statutory requirement of work of art and yet have useful functions.

The decision below holds in substance that a copyrighted statuette is not infringed by a copy intended for use as a lamp base on the theory that the Design Patent Law, not the Copyright Code, controls. If the Design Patent Law controls as to infringement, it also controls as to copyrightability, and the regulation and associated practice of the Copyright Office is wrong. In fact the opinion below is squarely based on the premise that a lamp base is not copyrightable even as to its artistic craftsmanship and hence cannot infringe the copyright to a statuette (R. 57-9).

The Regulation is perfectly clear that "works of artistic craftsmanship" are registrable as to "form but not their mechanical or utilitarian aspects." The

decision below, although quoting the Regulation (R. 58), reaches a wholly conflicting result for it holds that the addition of inconspicuous mechanical and utilitarian features—in no way altering the artistic impression—brings the copy outside the reach of the Copyright Code. The opinion also repeatedly emphasizes that artistic craftsmanship in a lamp base is not copyrightable. The conflict with the Regulation is irreconcilable and can only be resolved by a decision of this Court.

We have attached hereto (pp. 12-14) an exchange of correspondence between counsel for Petitioners and the Copyright Office. The letter of the Register of Copyrights, stating that "The Stein decision has raised a question about the above practice without in fact holding the rule invalid," aptly states the administrative dilemma arising from an opinion quoting from the Regulation while reaching an irreconcilable decision. The letter also makes it perfectly clear that it is the present position of the Copyright Office that the Regulation is correct, although the Office understandably does not commit itself as to the indefinite future.

The Catalogue of Copyright Entries decisively shows the public importance of this problem, both in terms of Copyright Office practice and in terms of the validity and scope of copyrights to works of art. The latest available catalog,* covering the six-month period from January 1950 to June 1950, shows a total of approximately 1000 registrations to statuettes and other three dimensional works of art of which approximately 500 are to artistic perfume bottles (pp. 1, 24); ash trays (pp. 23, 55); dolls and puppets (pp. 1, 18); flower baskets and vases (pp. 4, 17); salt shakers (pp. 4, 16); mugs, jars, etc. (pp. 5, 50); plates and dishes (pp. 5, 15); cemetery memorials (pp. 7, 21); jewelry (pp. 7, 16); lamps (pp. 8, 20); banks (pp. 14, 31); and a host of other artistic but useful objects complying with the Regulation and yet coming squarely within the proscription of the decision below.

* Ten copies filed with this Petition.

This Court has never passed upon Section 5(g) of the Copyright Code, its relation to the Design Patent Law, or upon Regulation 202.8. The time is ripe for a definitive decision, approving or disapproving the practice of the Copyright Office, to guide both the Copyright Office and authors of works of art in connection with their future conduct.

The public interest is never served by unresolved confusion. This Court should pass on this case to dispel the confusion.

2. The decision of the Court of Appeals directly conflicts with the unambiguous language of the Copyright Code.

For over 40 years the Copyright Law has listed "works of art" as one class of copyright subject matter (17 U. S. C. 5(g)). That law also awards the copyright proprietor the "exclusive right" to "copy and vend the copyrighted work" (17 U. S. C. 1(a)). The stautory language is unqualified. There is no statutory exclusion—either as to registration or infringement—with respect to works of art to which have been added elements, such as a lamp socket, to make a device that performs a useful function in addition to displaying the artistic creation.

In fact, while this case involves a lamp base embodiment of the copyrighted work of art, the principle of the decision below wholly denies to copyright owners any recourse against appropriation of their art in paper weights and similar devices which, like the lamp base, appropriate and take value from every artistic feature of the copyrighted statuette. This crippling result was never intended by Congress.

The Court of Appeals rested its opinion on the assertion that the Copyright Code does not "refer to articles of manufacture having a utilitarian purpose" (R. 58). True, but this is wholly irrelevant. The statute does say "works of art" and a work of art is necessarily an article of manufacture and, moreover, necessarily has utility—at least as a paperweight. In

fact, we cannot conceive of a statuette that cannot be made into a lamp by proper choice of size and the addition of socket, bulb, and shade—all without altering the artistic features of the statuette or making them less visible.

The Court was also heavily influenced by its own comparison of the procedural provisions of the Design Patent Law and the Copyright Code. That comparison wholly overlooked the fact that Congress, by the Copyright Code, concluded that the public interest is best served by making works of art copyrightable and unequivocally gave to the owners of all copyrights protection against unauthorized copying in any form. The courts have consistently enforced copyrights against appropriation, no matter how commercial or mundane the appropriation of the artistic concept (*i. e. Bleistein* v. *Donaldson,* 188 U. S. 239 (1903) (circus poster); *King Features* v. *Fleischer,* 299 Fed. 533 (C. A. 2, 1924) (doll reproduction of cartoon character); *Jones Bros.* v. *Underkoffler,* 16 Fed. Supp. 729 (M. D. Pa., 1936) (cemetery memorial)). The Copyright Office has similarly honored this Congressional choice by Regulation 202.8, making works of art copyrightable to the extent of their artistic characteristics regardless of the practical uses of the particular structure in which the art is incorporated.

The Copyright Code requires a work of art and no more. The decision below nullifies that plain language by reading into it the Design Patent Law which nowhere restricts the Copyright Code and is merely complementary to it. That decision is contrary to the first principle of statutory construction; namely, that an unambiguous statute is to be enforced as written. This Court should correct this mistaken construction and dispel the cloud over the existing registrations and those currently being granted by the Copyright Office.

None of the decisions cited by the Court of Appeals or by the District Court in any way supports this rewriting of the Copyright Code.

3. The decision below conflicts with decisions in other circuits, particularly decisions of the Court of Appeals for the Second Circuit. This conflict cannot be resolved without a decision by this Court.

In *Fleischer Studios* v. *Freundlich,* 73 F. (2d) 276 (C. A. 2, 1934), the Court held that a doll reproduction of the cartoon character "Betty Boop" infringed the copyrighted "Betty Boop" cartoons. In that case the copyright proprietor, through a licensee, had distributed thousands of toys and dolls like those accused (73 F. (2d) at p. 277). There was, and could be, no question but that the parties were in competition in selling dolls and that the dolls were articles of manufacture.

The fact of the conflict between the decision below and the *Fleischer* case is brought into sharp focus by the unsuccessful petition for certiorari filed in that case (No. 654, Oct. term 1934). That petition was based solely on the argument that the effect of the *Fleischer* decision was to extend the copyright law to cover subject matter exclusive to design patents. That petition, especially at pages 16 and 17, almost paraphrases the decision of the Court of Appeals in the present case.*

Fleischer v. *Freundlich* followed *King Features* v. *Fleischer,* 299 Fed. 533 (C. A. 2, 1924). The Court there held that a doll reproduction of "Spark Plug" infringed the copyright to the copyrighted "Barney Google" cartoons.

The Court of Appeals for the Second Circuit is not alone in its conflict with the decision below. For example, in *Jones Bros.* v. *Underkoffler,* 16 Fed. Supp. 729 (M. D. Pa., 1936), the Court held that a physical

* We appreciate that denial of certiorari is not necessarily approval of the merits of a case. Yet the denial of two petitions urging opposite sides of the same question cannot help but create confusion, especially as to the Copyright Office which must somehow distill a basis for its own future conduct from these mutually exclusive cases and authors of works of art who must take positive steps to protect their creations.

memorial, intended to hold the body of a deceased person, infringed a class G copyright. The Court, after detailed analysis, squarely rejected the contention that the memorial could only be protected by design patent because it was an article of manufacture and utilitarian in character.

The *Jones* case is one of the decisions relied upon by the Copyright Office in issuing Regulation 202.8 (This Petition, p. 13).

These decisions conflict with the decision below. Under them an "article of manufacture" not only may infringe a copyright but can do so even if the copyright is to a cartoon and the proprietor is in direct competition with the defendant in selling the "article of manufacture." This law cannot be reconciled with the decision in the present case that frees an exact copy from copyright liability because it is embodied in an "article of manufacture".

This conflict of decisions cannot be resolved without a ruling by this Court.

Conclusion.

The regulations and practice of the Copyright Office, the confusion created in the Copyright Office by the decision below, the unambiguous statutory language, and the conflict of circuits join to make this a case where certiorari should be granted in the public interest.

Respectfully submitted,

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W. W. GLENNY.

July 30, 1951.

COPYRIGHT OFFICE
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JUL 23 1951
BAIR, FREEMAN & MOLINARE

Bair, Freeman & Molinare
1400 Field Building
135 South La Salle Street
Chicago 3, Illinois

Gentlemen:

The three questions asked in your letter of July 17, 1951 are answered as follows:

1. Since the promulgation of Section 202.8 of the copyright regulations (37 C.F.R., Chapter II), it has been the practice of the Copyright Office to register copyright claims to works of art even though they may be adapted for or used as objects of a utilitarian character. The determining factor in such cases is whether the object deposited can in itself be considered a work of art.

This rule was based upon the holding of the courts that there was an overlapping of jurisdiction under the copyright law and design patent legislation, and that the creator of the work possessed an option to elect which type of protection to pursue. (See De Jonge & Co. v. Breuker & Kessler Co., 182 F. 150; In re Blood, 23 F(2d) 772; Jones Bros. Co. v. Underkoffler, 16 F. Supp. 729).

2. The Stein decision has raised a question about the above practice without in fact holding the rule invalid. The Office has not as yet fully considered the effect of this decision upon its future policies.

3. For the fiscal year ending June 30, 1950, 4,013 registrations were made in Class G which encompasses all works of art. Though

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the Office does not maintain a separate record of the number of registrations of claims to copyright in lamp bases and similar objects of possible utility, a perusal of the section of the Catalog of Copyright Entries covering works of art will show that a considerable number of the registrations relate to the types of works to which you have referred.

Sincerely yours,

William P. Siegfried

William P. Siegfried
Acting Register of Copyrights